



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/759,951

01/12/2001

Daryl Carvis Cromer

RPS920000082US1

3384

7590

01/27/2005

Bracewell & Patterson LLP
Intellectual Property Law
P O Box 969
Austin, TX 78767-0969

EXAMINER

LONG, HEATHER R

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,951

Applicant(s)

CROMER ET AL.

Examiner

Heather R Long

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 and 10 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Page 8, lines 20-27, filed August 10, 2004, with respect to the rejection(s) of claim(s) 1-16 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Steinberg (U.S. Patent 5,862,218).

Regarding claim 1, Steinberg discloses in Fig. 3 a method for generating and distributing a digital photographic proof, and the method comprising the steps of: generating an altered image by altering original image data to produce altered image data (col. 5, lines 49-56); storing the altered image data in an electric file (col. 5, line 66 - col. 6, line 3); storing encrypted instructions in the file with the altered image data, the instructions describing a method for reversing an alteration method utilized to alter the original image to produce the altered image

Art Unit: 2615

data; producing a digital photographic proof utilizing the file by displaying the altered image, wherein all users are permitted to view the altered image (col. 5, line 66 - col. 6, line 3; col. 4, lines 39-42); and permitting only authorized users to utilize the encrypted instructions to reproduce the original image from the altered image data, wherein only authorized users may produce the original image, and further wherein the single electronic file is utilized to both produce a digital photographic proof and to reproduce the original image (col. 4, lines 42-44; only authorized users know the password; col. 5, line 66 - col. 6, line 3).

Regarding claim 9, this is an apparatus claim corresponding to the method claim 1. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg as applied to claim 1 above, and further in view of Wilkins et al. (U.S. Patent Application Publication 2003/0231240).

Regarding claim 2, Steinberg discloses the subject matter as discussed with respect to claim 1 and further discloses utilizing the decryption key to

decrypt the encrypted instructions, wherein only authorized users may decrypt the encrypted instructions (col. 4, lines 42-44; only authorized users know the password; col. 5, line 66 - col. 6, line 3). However, Steinberg fails to disclose that the method further comprises the steps of: providing a decryption key in response to a user purchasing a right to reproduce the original image from the altered image, wherein the user becomes an authorized user in response to the purchase.

Referring to the Wilkins et al. reference, Wilkins et al. discloses a method for generating and distributing a photographic proof, comprising the steps of providing a decryption key in response to a user purchasing a right to reproduce the original image from the altered image, wherein the user becomes an authorized user in response to the purchase (paragraph [0045]). Although Wilkins et al. does not specifically state a decryption key, it is inherent that one would gain access to one once the user purchases rights to the high-resolution digital photo in order to decrypt the encryption key that has been used to secure the image.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of only letting authorized users to be the people who have purchased the right to the decryption key as taught by Wilkins et al. so that photographers have the right to their own images and can make a profit allowing others to copy and use their images.

Regarding claim **3**, Steinberg in view of Wilkins et al. disclose all the subject matter as discussed with respect to claims 1 and 2 including that the method further comprises the step of capturing the original image utilizing a digital camera (Steinberg - Fig. 1; col. 5, lines 45-49).

Regarding claim **4**, Steinberg in view of Wilkins et al. disclose all the subject matter as discussed with respect to claims 1-3 including that the method further comprises the steps of: generating the instructions describing the method for reversing the alteration method (Steinberg: col. 4, lines 24-30 and 39-44); encrypting the instructions (Steinberg: col. 4, lines 24-30); appending the encrypted instructions to the altered image data (Steinberg: col. 4, lines 24-30); col. 5, line 66 - col. 6, line 3); and storing the encrypted instructions and the altered image together in the file (Steinberg: col. 5, line 66 - col. 6, line 3).

Regarding claim **5**, Steinberg in view of Wilkins et al. disclose all the subject matter as discussed with respect to claims 1-3 including that the method further comprises the step of storing original image data outside of the camera (Steinberg: image data is stored on a floppy diskette), the original image data required in order to reproduce the original image (Steinberg: col. 4, lines 39-44).

Regarding claim **6**, Steinberg in view of Wilkins et al. disclose all the subject matter as discussed with respect to claims 1-3 and 5 including that the method further comprises the steps of: selecting the alteration method to use to alter the original image data (Steinberg: col. 4, lines 31-38; col. 5, lines 40-45); altering the original image data to produce the altered image data (Steinberg: col.

5, lines 49-52); and storing the altered image data in the electronic file (Steinberg: col. 5, line 66 - col. 6, line 3).

Regarding claim 7, Steinberg in view of Wilkins et al. disclose all the subject matter as discussed with respect to claims 1-3, 5, and 6 including that the method further comprises the steps of: generating the instructions describing the method for reversing the alteration method (Steinberg: col. 4, lines 24-30 and 39-44); encrypting the instructions (Steinberg: col. 4, lines 24-30); appending the encrypted instructions to the altered image data (Steinberg: col. 4, lines 24-30); and storing the encrypted instructions and the altered image together in the file (Steinberg: col. 5, line 66 - col. 6, line 3).

Regarding claim 8, Steinberg discloses all the subject matter as discussed with respect to claim 1 including that the method further comprises the step of distributing the digital photographic proof in a digital format utilizing a floppy diskette (col. 3, lines 52-54). However Steinberg fails to mention distributing the digital photographic proof to a potential buyer.

Referring to the Wilkins et al. reference, Wilkins et al. discloses a method for generating and distributing a photographic proof, comprising the steps of providing a decryption key in response to a user purchasing a right to reproduce the original image from the altered image, wherein the user becomes an authorized user in response to the purchase (paragraph [0045]). Although Wilkins et al. does not specifically state a decryption key, it is inherent that one would gain access to one once the user purchases rights to the high-resolution

digital photo in order to decrypt the encryption key that has been used to secure the image.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of only letting authorized users to be the people who have purchased the right to the decryption key as taught by Wilkins et al. so that photographers have the right to their own images and can make a profit allowing others to copy and user their images.

Regarding claims **10-16**, these are apparatus claims corresponding to the method claims 2-8. Therefore, claims 10-16 are analyzed and rejected as previously discussed with respect to claims 2-8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R Long whose telephone number is 703-305-0681. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thai Tran can be reached on (703) 305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Heather R Long
Examiner
Art Unit 2615

HRL
January 24, 2005



TUAN HO
PRIMARY EXAMINER